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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,514	06/26/2003	Daniel A. Wilson	19947-6A	6021
24256	7590	02/23/2006	EXAMINER	
DINSMORE & SHOHL, LLP 1900 CHEMED CENTER 255 EAST FIFTH STREET CINCINNATI, OH 45202			GRAY, JILL M	
			ART UNIT	PAPER NUMBER
			1774	
DATE MAILED: 02/23/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/607,514

Applicant(s)

WILSON ET AL.

Examiner

Jill M. Gray

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/27/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 29-50 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Szum 6,240,230 B1, for reasons of record.

Szum is as set forth previously and teaches a cured material comprising about 20 wt% to about 80 wt% of a polyether based urethane acrylate oligomer, about 20 wt% to about 80 wt% of a monomer diluent and an effective amount of a photoinitiator, as required by claims 33, 36, and 37, wherein said cured material having an elongation at break and modulus within applicants' claimed range. Regarding claims 29-30, because the composition defined by present claims 33-38 further defines the radiation cured

material of claim 29, the examiner has reason to believe that a composition that is substantially the same as or similar to that contemplated by applicants in claims 33-38, such as the composition taught by Szum, necessarily results in the requisite tear strength and adhesion force. As set forth previously, products of identical chemical composition cannot have mutually exclusive properties and there is no clear factual evidence on this record that the prior art composition does not necessarily possess the characteristics of the instant claimed product. As to claims 31-32, 42-43, and 48, it should be noted that Szum teaches that proper modulus is important and can be at least about 8 MPa to greater than 25 MPa (column 7, lines 62-67) and that the composition can be tailored for different utilities and the modulus adjusted accordingly, such as a modulus of less than about 2,000 psi for single optical fiber coatings. See column 13, lines 64-66. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form a radiation cured material of the type contemplated by applicants in present claims 29-50, motivated by the teachings of Szum.

Response to Arguments

4. Applicant's arguments filed December 27, 2005 have been fully considered but they are not persuasive.

Applicants argue that Szum provides no teaching or suggestion as to the tear resistance or adhesion force to an underlying surface material exhibited by the compositions and that in view of the failure of Szum to more specifically disclose a composition along the lines of those exemplified in the present application as exhibiting

a tear resistance and an adhesion force as recited in claim 29 and claim 51 further arguing that the examiner has no basis to assert that the teachings of Szum inherently exhibit the properties presently claimed and anticipate the claimed materials.

In this regard, the examiner's position remains that the same composition necessarily has the same properties and there is no clear factual evidence on this record, by way of back-to-back comparison that the composition of the prior art does not result in the claimed critical properties.

Applicants argue that the exemplary teachings of Szum disclose compositions that are significantly distinguishable from those exemplified in the present application and that the examiner's assertion of inherency must be limited to the examples as the broad teachings of Szum cannot support any anticipation rejection under 35 U.S.C. 102.

In response thereto, as set forth previously, all of the disclosure in a reference must be evaluated for what they fairly teach one of ordinary skill in the art whereby the teachings of Szum would have put one of ordinary skill in the art in possession of that which applicants regard as their invention. In addition, there is no factual evidence on this record, by way of back-to-back comparison that clearly demonstrates that the composition of the prior art does not have the claimed critical properties.

Applicants argue that they fail to find any teaching by Szum relating to a radiation cured encapsulated material having a modulus as recited in claim 51, in combination with the tear resistance and adhesion force required by claim 51 nor any teaching or suggestion by Szum relating to a radiation cured material having a modulus in the specific range recited in claim 51 in combination with the tear resistance and adhesion

force properties recited in claim 51, further arguing that there is no teaching or suggestion in the broad teachings of Szum for one of ordinary skill in the art to prepare a radiation cured encapsulating material as presently claimed.

It is the position of the examiner that silence does not provided evidence of the absence of these properties. As set forth previously, there is no factual evidence on this record clearly substantiating applicants' arguments.

No claims are allowed.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

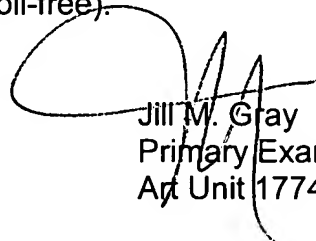
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-Th and alternate Fridays 10:30-7:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jill M. Gray
Primary Examiner
Art Unit 1774

jmg